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| APPLICATION NUMBER | FILING DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO. |
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08/471,622 06/15/95

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| EXAMINER |
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| ART UNIT | PAPER NUMBER |
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1212 DATE MAILED:

06/02/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- Responsive to communication(s) filed on 2/25/97 (page 18)
- This action is FINAL.
- Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- Claim(s) 1 - 75 is/are pending in the application.
Of the above, claim(s) 34 - 65 is/are withdrawn from consideration.
- Claim(s) _____ is/are allowed.
- Claim(s) 1 - 33, 66 - 79 is/are rejected.
- Claim(s) _____ is/are objected to.
- Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The drawing(s) filed on _____ is/are objected to by the Examiner.
- The proposed drawing correction, filed on _____ is approved disapproved.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All Some* None of the CERTIFIED copies of the priority documents have been
- received.
- received in Application No. (Series Code/Serial Number) _____
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- Notice of Reference Cited, PTO-892
- Information Disclosure Statement(s), PTO-1449, Paper No(s). 5
- Interview Summary, PTO-413
- Notice of Draftsperson's Patent Drawing Review, PTO-948
- Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES-

part III DETAILED ACTION

5 - RESTRICTION

1. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

Group I. Claims 1-33, 66-79, drawn to a pluarality of expression vectors, a cloning system for making said vectors, and 10 cells transformed therewith, classified in Class 435, subclass 69.1.

Group II. Claims 34-43, drawn to a a method of constructing a diverse population of vectors, classified in Class 935, subclass 23.

Group III. Claims 44-54, drawn to a method for selecting a heteromeric receptor, classified in Class 935, subclass 79.

Group IV. Claims 55-65, drawn to a method of sequencing a receptor gene, classified in Class 935, subclass 77.

Claims 64 and 65 have been included in group IV because they 20 are presumed to depend from claim 55 since this dependency more logically follows the claim language. Claims 64 and 65, as written, depend from claim 50 of group III. If this presumption of dependency is incorrect then these claims will be included in group III and treated accordingly.

Inventions II and I are related as process of making a 25 product made. The inventions are distinct if either or both of

the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (M.P.E.P. § 806.05(f)). In the instant case 5 the vectors of invention II could be used in a plurality of different cloning projects unrelated to the generation of a cell population containing diverse combinations of receptors.

Inventions III and I are related as process of making a product made. The inventions are distinct if either or both of 10 the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (M.P.E.P. § 806.05(f)). In the instant case the product can be made by a materially different process such as 15 randomized site directed mutagenesis of a single vector encoding two polypeptides separately.

Invention I is related to inventions III and IV as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process 20 for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the product can be used in at least two materially different processes as indicated 25 by inventions III and IV.

Groups I-IV are directed to a product and methods that are distinct physically, chemically and functionally, and are therefore patentably distinct. Group I is drawn to a functionally and chemically distinct product whereas groups II-
5 IV, drawn to materially different processes, each from each other and from the product of group I. Each of the inventions of Groups I-IV can be made and used without the other. The four disclosed inventions of Groups I-IV are distinct because each of the product and processes can be made and used each without the
10 other and in addition because these four inventions lack a common utility which is based on a common technical or structural feature.

Because a search of any of these three distinct inventions would not be co-extensive with a search of the others, an
15 examination and search of two or more inventions in a single application would constitute a serious undue burden on the examiner.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of
20 their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

- ELECTION

3. Telephone calls were made on 20 September 1996 to David Gay.
25 to request an oral election to the above restriction requirement,

but did not result in an election, but rather a request for the restriction in writing.

- JOINT INVENTORS, CORRECTION OF INVENTORSHIP

5 Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of the inventorship
10 must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

15 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth A. Sorensen at telephone number (703) 305-5377. The examiner can normally be reached on Monday through Friday from 9:00 a.m. to 5:30 p.m.

20 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Walsh can be reached on (703) 308-4232. The FAX phone number for this group is (703) 308-0294.

25 Any inquiry of general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

30 Kenneth A. Sorensen
Examiner
Group 1800

KAS/15.Jan.97

Stephen Walsh
STEPHEN WALSH
SUPERVISORY PATENT EXAMINER
GROUP 1800